

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 23, 2003. Applicant respectfully requests reconsideration and favorable action in this case in light of the following remarks.

Section 103 Rejections

Claims 1-11 and 13-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,271,752 to Vaivos ("*Vaivos*") in view of U.S. Patent No. 6,028,626 to Aviv ("*Aviv*"), and further in view of U.S. Patent Application No. 5,629,981 to Nerlikar ("*Nerlikar*"). In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143.

In the present case, a *prima facie* case of obviousness cannot be maintained against Claim 1 because neither *Vaivos*, *Aviv*, nor *Nerlikar* provides a suggestion or motivation to combine the references. The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art" at the time of the invention. M.P.E.P. 2143.01. The "fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination" or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).²

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together elements of *Nerlikar* with those of *Vaios*. *Nerlikar* relates to a document access system that uses RFID badges worn by users to control the users' access to the documents. The fact that both systems use RFID tags does not alone provide a suggestion

¹ Note M.P.E.P. 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

to combine any aspects of the two systems. The Examiner states, using the benefit of hindsight, that it would be useful to provide “an audit trail of each user defined transaction as taught by *Nerlikar*” in the remote surveillance system disclosed in *Vaios*. However, the Examiner has not explained how such an audit trail would be used in the system of *Vaios*. For example, what are the “user defined transactions” in the *Vaios* system that would be audited? Furthermore, even if some use of an audit trail could be identified, there is simply no suggestion to use such an audit trail (or otherwise to process RFID data to generate a report for the subscriber, as recited in Claim 1) in the system of *Vaios*. *Nerlikar* only suggests that an audit trail is useful in its document access system – there is no suggestion that an audit trail could be used in the remote surveillance system disclosed in *Vaios*. Without such a suggestion in the references or in the knowledge of persons skilled in the art, the combination cannot be made. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, as well as the claims which depend from Claim 1.

Furthermore, in addition to being allowable due to its dependence on Claim 1, Claim 8 also recites additional limitations not disclosed in *Vaios*, *Aviv*, or *Nerlikar*. For example, Claim 8 recites “initiating a polling event in response to a specified event, the polling event operable to use the RFID system at the facility to poll an area of the facility to determine an inventory of tagged items within the area.” The Examiner has not provided any indication as to how this entire limitation is disclosed by either reference. Although the Examiner provides arguments regarding the initiation of a polling event in response to a per-defined time or periodic event, the Examiner does not explain how any cited reference discloses, teaches or suggests that “the polling event operable to use the RFID system at the facility to poll an area of the facility to determine an inventory of tagged items within the area.” For at least this additional reason, Applicant respectfully requests reconsideration and allowance of Claim 8.

Moreover, a *prima facie* case of obviousness cannot be maintained against independent Claims 15 and 20 because *Vaios*, *Aviv*, and *Nerlikar*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention fail to disclose all of the elements of these claims. For example, independent Claim 15 recites, “eliciting a radio response from

a radio frequency identification (RFID) tag at an access door of a secure area,” “determining whether access by a wearer of the RFID tag to the secure area is authorized based on the radio response” and “controlling access to the door to provide access to the secure area by the wearer only if access by the wearer is authorized.” The present Office Action does not address any of these limitations (the Office Action only addresses the limitations of independent Claim 1). However, the Examiner did address these limitations in the “Response to Arguments” section of the Office Action mailed on September 20, 2004. Applicant addressed the Examiner’s comments in the Response filed with the Request for Continued Examination in this case, but the present Office Action does not address the Applicant’s arguments.

To reiterate, the Examiner stated the following in regards to Claim 15 in the Office Action mailed on September 20, 2004: “[T]he examiner reminds the applicant that the RF-ID interrogation steps are present in Aviv col. 9, lines 60-67 and in col. 10, lines 1-12. The applicant is reminded that the result of the interrogation in Aviv will give access to the authorized individual as is required for anyone accessing the remote surveillance system disclosed in Vaios (See Vaios col. 4, lines 5-14 and lines 61-65).” However, neither *Vaios*, *Aviv*, nor *Nerlikar* disclose controlling access to anything, much less a door of a secure area, based on a radio response from an RFID tag. Furthermore, although Vaios may disclose providing remote *computer* access to the *security surveillance system* disclosed in that reference, it does not disclose controlling *physical* access by a wearer of an RFID tag to a *door of a secure area*. Furthermore, there is simply no suggestion to combine the use of RFID tags disclosed in *Aviv* to control access to anything, much less a door of a secure area. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claim 15, as well as the claims that depend from Claim 15.

Similarly, the present Office Action does not address any of the limitations of independent Claim 20 (again, the Office Action only addresses the limitations of Claim 1). Independent Claim 20 recites, “determining whether the RFID action corresponds to a pre-defined alert condition.” As Applicant has noted twice before, the Examiner has not cited any passage of any reference for a teaching of this limitation. Applicants respectfully request

that the Examiner address this limitation. Furthermore, Claim 20 was amended in the Request for Continued Examination to recite "obtaining a video image associated with the RFID action *only* if the RFID action corresponds to a pre-defined alert condition." The Examiner has also failed to address this limitation in the present Office Action. Accordingly, Applicant respectfully requests reconsideration and allowance of Claim 20, as well as those claims that depend from Claim 20.

CONCLUSION

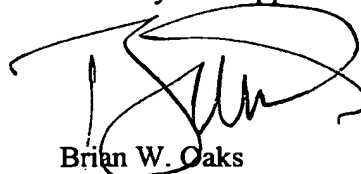
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further request that the Examiner contact the undersigned attorney to schedule the telephone conference.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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